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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,327

12/08/2003

Avtar S. Dhindsa

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

01/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/731,327

Applicant(s)

DHINDSA, AVTAR S.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8-28 and 35-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-28 and 35-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/22/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on October 10, 2007, the following new and reiterated grounds of rejection are set forth:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 6, 8-15 and 35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 16, 18, 20 and 35 of U.S. Patent No. 6,533,720. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are merely broader in scope than those the cited patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 8-25 and 35-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,567,880 to Goodman in view of U.S. Patent No. 6,221,007 to Green.

In regards to claims 2-6, 9, 12-14, 17-21 and 36-46, Goodman discloses an endoscope valve assembly comprising: a housing 58 comprising an opening; an inlet port 74/78 configured to be releasably connected to a source of irrigation fluid; an outlet port 76/80 configured to be releasably connected to an irrigation port of a medical endoscope; a valve carried by the housing and comprising a manually-controlled actuator movable between a first position, in which the valve blocks flow between the inlet port and the outlet port, and a second position, in which the valve allows flow between the inlet port and the outlet port; a latch operative to releasably hold the actuator in a selected position; and a mounting surface having a non-linear shape to allow the endoscope valve assembly to fit on medical endoscopes with different shapes, wherein the mounting surface comprises a surface of a mounting pad (see Figs. 1-5 and Col. 6, Lines 1-51). Goodman is silent with respect to a strap configured to secure to the housing through the opening and configured to releasably secure the endoscope valve assembly to the medical endoscope. Green an analogous endoscopic system

comprising a strap 85 of adjustable length and an adjustment knob 90 with which the strap can be shortened until it firmly grips the endoscopic head (see Fig. 1 and Col. 7, Lines 24-41). Furthermore, Green teaches a wrist strap 1270 that is releasably secured to a surgeon's wrist during use through a fastener. Thereby the weight of the accessory is transferred to the surgeon's wrist and not to the endoscope or surgeons fingers (see Fig. 42 and Col. 20, Lines 23-35). Thus, Green teaches the desirability of attaching accessories to the external housing of an endoscope, or a surgeon's wrist, via a strap. It would have been obvious to one skilled in the art at the time the invention was made to secure the valve assembly of Goodman to the endoscope using a strap to provide increased efficacy in the adjustability of attaching the valve to a variety of endoscopes as taught by Green.

In regards to claims 8, 10-11, 15-16, 22-25 and 35, Goodman discloses an endoscope valve assembly comprising: a housing 58; an inlet port 74/78 configured to be releasably connected to a source of irrigation fluid; an outlet port 76/80 configured to be releasably connected to an irrigation port of a medical endoscope; a valve carried by the housing and comprising a manually-controlled actuator movable between a first position, in which the valve blocks flow between the inlet port and the outlet port, and a second position, in which the valve allows flow between the inlet port and the outlet port; and a mounting surface having a non-linear shape to allow the endoscope valve assembly to fit on medical endoscopes with different shapes; and a mechanical fastener configured to releasably secure the endoscope valve assembly to the medical endoscope (see Figs. 1-5, Col. 3, Lines 5-32 and Col. 6, Lines 1-51). Goodman is silent

with respect to wherein the mounting surface comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing. Green teaches of an analogous endoscopic system wherein a video display 150 is releasably affixed to the cannula by mounting means comprising a support member 154, a Velcro strip 155, adhesively bonded to the support member and a corresponding fabric anchoring strip 160 adhesively bound to the cannula (see Fig. 5 and Col. 8, Lines 36-46). Thus, Green demonstrates that it is well known in the art to secure an apparatus to the body of an endoscope via a mounting pad comprising a resilient material and separately formed from the housing. It would have been obvious to one skilled in the art at the time the invention was made to secure the valve assembly of Goodman to the endoscope using a mounting pad to provide increased efficacy in the adjustability of attaching the valve to a variety of endoscopes as taught by Green.

Claims 8, 10-11, 15-16, 26-28 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,201,908 to Jones in view of U.S. Patent No. 6,221,007 to Green.

In regards to claims 8, 10-11, 15-16 and 35, Jones discloses an endoscope valve assembly comprising: a housing 100; an inlet port 130 configured to be releasably connected to a source of irrigation fluid; an outlet port 138 configured to be releasably connected to an irrigation port of a medical endoscope; a valve carried by the housing and comprising a manually-controlled actuator movable between a first position, in which the valve blocks flow between the inlet port and the outlet port, and a second position, in which the valve allows flow between the inlet port and the outlet port; and a

mounting surface having a non-linear shape to allow the endoscope valve assembly to fit on medical endoscopes with different shapes, and a mechanical fastener 104 configured to releasably secure the endoscope valve assembly to the medical endoscope (see Figs. 9-10 and Col. 6, Line 50 – Col. 7, Line 50). Jones is silent with respect to wherein the mounting surface comprises a surface of a mounting pad comprising a resilient material and separately formed from the housing. Green teaches of an analogous endoscopic system wherein a video display 150 is releasably affixed to the cannula by mounting means comprising a support member 154, a Velcro strip 155, adhesively bonded to the support member and a corresponding fabric anchoring strip 160 adhesively bound to the cannula (see Fig. 5 and Col. 8, Lines 36-46). Thus, Green demonstrates that it is well known in the art to secure an apparatus to the body of an endoscope via a mounting pad comprising a resilient material and separately formed from the housing. It would have been obvious to one skilled in the art at the time the invention was made to secure the valve assembly of Jones to the endoscope using a Velcro mounting pad to more securely attach the valve to a variety of endoscopes as taught by Green.

In regards to claims 26-28, Jones discloses an endoscope valve assembly, further comprising a second inlet port operative to connect a suction source 132 and a second valve carried by the housing and coupled between the second inlet port and the outlet port, the second valve comprising a manually-controlled second actuator movable between a third position, in which the second valve blocks flow between the second inlet port and the outlet port, and a fourth position, in which the second valve allows flow

between the second inlet port and the outlet port (see Figs. 9-10 and Col. 6, Line 50 – Col. 7, Line 50).

Response to Arguments

Applicant's arguments with respect to claims 2-6, 8-28 and 35-46 have been considered but are moot in view of the new ground(s) of rejection.

Applicant states that Goodman fails to disclose a valve that fits on a medical endoscope and that the valve is part of the endoscope. Examiner disagrees. Goodman clearly discloses that the valve unit 46 which is mounted on the bridge element 42 (see Fig. 2 and Col. 34-56). The valve is also intended to be used on a variety of endoscope as Goodman discloses that the instant invention provides an effective endoscopic device which can be embodied in various forms for endoscopy of various parts of the human body, including the ureter, and it includes means for effectively controlling the irrigation and drainage of fluids in the area of the body being treated (see Col. 2, Lines 62-68).

Applicant states that the endoscope of Jones does not have an irrigation port. Examiner disagrees. The access channel may channels 60 may be separate tubular channels extending axially between the main endoscope channel 37 and the wall of the sheath 30 as illustrated in FIG. 8. Alternately, the endoscope as a whole may be interpreted as including the sheath and the irrigation ports as seen in Figure 9.

Furthermore, the terminal disclaimer filed October 22, 2007 was disapproved, thus the non-statutory obviousness-type double patenting rejection of claims 2, 6, 8-15, over various claims in U.S. Patent No. 6,533,720 stand.

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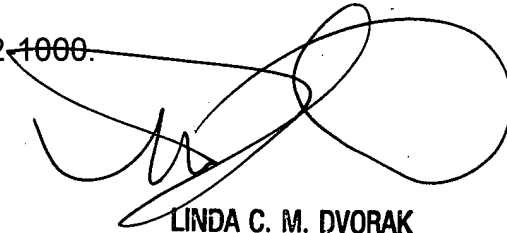
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *MR*
1/4/8



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